

REMARKS

I. Introduction

Claims 1 and 6 to 25 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 6 to 13, and 15 to 25 Under 35 U.S.C. § 103(a)

Claims 1, 6 to 13, and 15 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of PCT International Patent Application Publication No. WO 02/27645 ("Franzen"), "Hyper-Redundant Robot Manipulators Actuated by Optimized Binary Dielectric Polymers" ("Wingert et al."), and U.S. Patent No. 6,373,472 ("Palalau et al."). It is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not render unpatentable the present claims for at least the following reasons.

The Final Office Action appears to suggest modifying the device of Franzen to include an actuator layer on an outer surface of the display. In particular, the Final Office Action appears to contend that it would have been obvious to use an actuator material disclosed by Wingert et al. in the transparent sensor layer S1 of Franzen. Applicant respectfully disagrees.

According to Franzen, the transparent layer S1 is disposed above the display layer S2. See Figure. The actuator of Wingert et al. is disclosed as including an elastomeric film coated on both sides with electrodes. See, e.g., Figure 2. Referring to Wingert et al., there is no indication whatsoever that either of the elastomeric film and the electrode coating is transparent. Absent transparency, the proposed modification would **render the device of Franzen unfit for its intended purpose**, as the display layer S2 would not be visible through the layer S1. As such, the proposed combination would not form a sufficient basis for a prima facie case of obviousness. See M.P.E.P. § 2143.01(V). Further, Franzen discloses that the transparent sensor layer S1 "is configured in such a way that the touch is detected and at least one first signal is generated, which determines at least the location (Cartesian coordinates) of the touch." English translation of Franzen, page 8. There is no indication whatsoever that forming the sensor layer of the materials and structure disclosed by Wingert et al. would allow touch detection.

Moreover, the device of Franzen provides a flexible display layer S2 and a flexible, transparent sensor layer S1, both of which are disposed over a third layer S3 that includes piezoelectrically actuated knobs that “punctiformly mechanically manipulate the first two layers S1 and S2.” English translation of Franzen, page 10. Rather than having the display and sensor layers S1 and S2 manipulated by the actuator of the third layer, the modification suggested by the Final Office Action would result in a sensor layer that is self-actuating. Thus, the proposed modification would **change the principle of operation** of the reference, and is therefore an insufficient basis for a prima facie case of obviousness. See M.P.E.P. § 2143.01(VI).

Furthermore, the Office Action has not established a prima facie case of obviousness as required under KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007) or in compliance with the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103,” M.P.E.P. § 2141 (“the Guidelines”). In this regard, as set forth in the Guidelines, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of reasons why the claimed subject matter would have been obvious, and rejections for want of obviousness cannot be sustained by mere conclusory statements. Rather, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Among the rationales enumerated in the Guidelines and at M.P.E.P. § 2143 are: (a) combining prior art elements according to known methods to yield predictable results; (b) simple substitution of one known element for another to obtain predictable results; (c) use of known technique to improve similar devices (methods, or products) in the same way; (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (e) “obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See also KSR International Co. v. Teleflex Inc., 550 U.S. at ___, 82 U.S.P.Q.2d at 1395 to 97.

The present rejection appears to be relying on a teaching, suggestion or motivation rationale. However, to reject a claim based on this rationale, M.P.E.P. § 2143(G) states that the Examiner ***must*** articulate: (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. See also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360, 80 U.S.P.Q.2d 1641, 1645 (Fed. Cir. 2006) (“We thus consider whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so.”).

As regards the finding that there was some teaching, suggestion, or motivation to modify or combine the references, the Final Office Action states that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the actuator of Franzen to have the material of as taught by Wingert so as to achieve improved performance by incorporating an elastic passive element to maintain uniform force-displacement characteristic and bi-stable action.

Final Office Action, page 3, lines 2 to 6 (internal quotation marks omitted). It is noted, however, that the “actuator” of Franzen would appear to be the piezoelectrically actuated knob matrix if the third layer S3 -- ***not*** the transparent sensor layer S1. In this regard, the Final Office Action has not articulated a finding that there is some teaching, suggestion, or motivation to incorporate the actuator of Wingert et al. into the transparent sensor layer S1, ***rather than the third layer S3***. Further, the Final Office Action fails to articulate a finding that there was reasonable expectation of success in forming the transparent sensor layer of Franzen from the electrode coated elastomeric film of Winger et al. Thus, it is respectfully submitted that the Final Office Action has failed to establish a prima facie case of obviousness for these additional reasons.

Palalau et al. does not cure the aforementioned deficiencies of the present rejection.

In view of the foregoing, it is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not disclose, or even suggest, an actuator layer arranged on an outwardly facing side of a display and including (a) a material having a reversibly and controllably changeable volume and (b) an operating surface geometry deformable as a function of a control signal generated by at least one of (a) a computation device and (b) a logic circuit, as recited in claim 1. As such, it is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not disclose or suggest all of the features recited in claim 1 and thus does not render unpatentable claim 1.

As for claims 6 to 13, 15 to 19 and 23 to 25, which ultimately depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not render unpatentable these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claim 14 Under 35 U.S.C. § 103(a)

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Franzen, Wingert et al., Palalau et al., and U.S. Patent Application Publication No. 2004/0017362 ("Mulligan et al."). It is respectfully submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not render unpatentable claim 14 for at least the following reasons.

Claim 14 depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, Franzen, Wingert et al., and Palalau et al., alone or in combination, do not disclose or suggest all of the features recited in claim 1. Mulligan et al. does not disclose or suggest the features of claim 1 not disclosed or suggested by the combination of Franzen, Wingert et al., and Palalau et al.

In view of the foregoing, it is respectfully submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not

disclose, or even suggest, all of the features of claim 14. As such, it is respectfully submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not render unpatentable claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully submitted.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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